

### **REMARKS**

Claims 1, 4, 9, 12-22, 27, 29-40, 44, and 47 are pending in the present application. Claims 42, 43, 45, 46, 48, and 49 are hereby canceled. Claims 1, 9, and 33 have been amended. Claims 1, 9, and 33 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

#### **Interview of March 21, 2008**

Applicants wish to thank Examiner Mylinh Tran and Primary Examiner Ba Huynh for taking the time to discuss the present application with Applicants' representative, Jason Rhodes (Reg. No. 47,305), during the personal interview on March 21, 2008.

**Claims Discussed:** Independent claims 1, 9, 33.

**Prior Art Discussed:** U.S. Patent No. 5,463,725 to Henckel et al. (hereafter "Henckel"); Hutchinson et al., *Microsoft® PowerPoint® 97 for Windows®* (hereafter "Hutchinson").

**General Results:** Although no agreement could be reached with respect to the claims in their current form, the parties agreed upon additional elements to be inserted into the claims by amendment to overcome the current grounds of rejection based on Henckel and Hutchinson. However, the Examiner and Primary Examiner indicated that further consideration and an update search would be necessary.

#### ***Rejection Under 35 U.S.C. § 103***

Claims 1, 9, 22, 27, 31, 33-40, 42-45, and 47-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henckel in view of Hutchinson. Further, claims 4, 12, 30, and 32 stand rejected under § 103(a) as being unpatentable over Henckel, Hutchinson, and further in view of U.S. Patent No. 6,407,757 to Ho (hereafter "Ho"). These rejections are respectfully traversed.

Even though Applicants believe that the § 103 rejections are improper at least for reasons set forth in pages 8-11 of the Amendment filed December 5, 2007 (hereafter “previous Amendment”), Applicants have amended independent claims 1, 9, 33 above in an effort to expedite prosecution.

As amended, independent claims 1 and 9 now recites the following:

- the interactive region is in proximity of the displayed page number;
- in response to the user tapping the area to the right of the page number, the navigational functionality is carried out by replacing the displayed page with a subsequent page in the document; and
- in response to the user tapping the area to the left of the page number, the navigational functionality is carried out by replacing the displayed page with the previous page in the document.

These amendments are supported, e.g., in Fig. 5 and page 13, 1<sup>st</sup> paragraph, of the specification. It is respectfully submitted that the amendments of claims 1 and 9 incorporate the substantive elements agreed upon during the March 21, 2008 interview, even though the actual language has been modified slightly.

Further, independent claim 33 has been amended similar to claims 1 and 9, except that amended claim 33 refers to a displayed *element of the immersive page*, rather than displayed page number. I.e., amended claim 33 now recites that the interactive region is in proximity to the displayed *element*, and that tapping to the right or left of the *element* causes a subsequent or previous page to be displayed.

In view of the agreement reached during the March 21, 2008 interview, Applicants respectfully submit that the amended claims are now allowable over the applied references and, thus, the § 103 rejections should be withdrawn. However, Applicants wish to offer the following

additional remarks as to why the presently pending claims are allowable over the applied references.

### **I. Applied Art Fails to Teach or Suggest Every Claimed Feature**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added).

#### **A. Tapping Neither Taught Nor Suggested:**

Independent claims 1, 9, and 33 recite the navigational functionality being carried out in response to the user tapping the touch-sensitive display at an interactive region, which spans only a portion of the page. Conversely, Henckel teaches using a finger-swiping motion to change pages, and Hutchinson teaches using a mouse click to navigate between slides. In fact, Henckel directly teaches away from tapping, teaching the desirability of a user moving her finger across the screen because it is more intuitive in that it simulates the turning of a page in an actual book (see col. 1, lines 49-58; col. 2, line 44-66).

#### **B. Taking of Official Notice Traversed:**

In the Response to Arguments, the Examiner agrees that neither Henckel nor Hutchinson teaches the claimed tapping. However, the Examiner takes official notice that tapping an interactive region was well known in the art. Applicants respectfully traverse this taking of official notice. First, the claims do not simply recite tapping. Instead, the relevant claim feature is the tapping of a touch-sensitive display at a particular region to carry out navigational functionality. Further, Applicants respectfully refer the Examiner to MPEP § 2133.03.A, 2<sup>nd</sup> paragraph, which states,

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Here, the question of whether the aforementioned claim feature was well known is not capable of instant and unquestionable demonstration. Further, the Examiner has failed to provide any factual findings to support the conclusion that such feature was well-known (see MPEP § 2144.03.B). Accordingly, if the Examiner decides to maintain this rejection, Applicants respectfully demand that the Examiner provide documentary evidence that it was well known for a user to tap a particular region of a touch-sensitive display to carry out navigational functionality of an electronic document.

In view of the foregoing, the Examiner has failed to provide the requisite teaching of navigational functionality being carried out in response to the user tapping the touch-sensitive display at an interactive region.

**C. Transparent Navigational Functionality Neither Taught Nor Suggested:**

Further, independent claims 1, 9, and 33 recite that the navigational functionality is transparent to the user prior to the user tapping the touch-sensitive display at the interactive region. In the previous Amendment, Applicants argued that the proposed combination of Henckel and Hutchinson would not teach or suggest this feature, because the resultant device would contain Hutchinson's arrow buttons which are displayed (and thus not transparent) to the user. However, in the Response to Arguments, the Examiner argues that Henckel is being relied upon for the transparent functionality feature. In support, the Examiner argues that Henckel teaches that the user's finger-swiping motion starts somewhere on the page.

Applicants submit that the test of obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. The Examiner asserts that Hutchinson's displayed left and right buttons teach "interactive regions," and thus proposes to modify Henckel to include Hutchinson's interactive regions. Thus, the Examiner proposed combination of Henckel and Hutchinson necessarily includes navigational buttons which are displayed to the user. Thus, the combined teachings of Henckel and Hutchinson do not teach or suggest navigational functionality that is transparent to the user prior to tapping, as claimed.

Further, to teach the feature of transparent navigational functionality, the Examiner relies on the very teaching in Henckel which needed to be modified in view of Hutchinson. In other words, the reason that Henckel does not teach or suggest the claimed feature of interactive region spanning only a portion of the page is that Henckel's user may start the swiping motion anywhere on the screen. Thus, according to the Examiner's proposed modification of Henckel in view of Hutchinson, the user will cannot be allowed to simply start the finger-swiping anywhere on the page to carry out navigational functionality. Instead, the user must click on one of Hutchinson's non-transparent interactive regions (buttons) to carry out navigational functionality. For this additional reason, the combination of Henckel and Hutchinson does not teach transparent navigational functionality prior to tapping, as claimed.

## **II. Proposed Modification Renders Henckel's Invention Unsatisfactory for Intended Purpose**

According to MPEP § 2143.01.V (as well as binding case law), it is improper under § 103 for the proposed modification of a prior art invention to render that invention being modified unsatisfactory for its intended purpose. However, the Examiner's rejection proposes a modification of Henckel that would lead to Henckel's invention being unsatisfactory for at least two intended purposes.

### **A. Modifying Henckel to Include Tapping is Improper:**

As discussed above, one of Henckel's intended purposes is to allow the user to turn pages of an electronic book in an intuitive way. According to Henckel, the most intuitive way is for the user to swipe her finger across the screen in the direction of page turning because it is very similar to the motion of turning a page in an actual book (see Henckel at col. 1, lines 52-58; col. 2, lines 44-66). However, the Examiner proposes modifying Henckel to replace this finger-swiping motion with a tapping. This would render Henckel unsatisfactory for its intended purpose of simulating the motion of turning a page in an actual book. In addition, this modification would change a major principle of operation of Henckel's invention, which is also improper under § 103 (see MPEP § 2143.01.VI).

**B. Modifying Henckel to Include Hutchinson's Interactive Region is Improper:**

Further, Henckel teaches that the use of a mouse or other pointer device to click on paging buttons is not particularly intuitive for certain users (see col. 1, lines 36-41). Thus, another of Henckel's intended purposes is to avoid the use of such buttons, in favor of its more intuitive finger-swiping motion. For this additional reason, the Examiner's proposed modification of Henckel to include Hutchinson's interactive regions (i.e., left and right buttons) would render Henckel unsatisfactory for its intended purpose of avoiding the use of buttons. For this additional reason, the Examiner's rejection is improper under § 103.

**III. Ho Does Not Remedy Deficiencies of Henckel/Hutchinson**

Applicants respectfully submit that Ho fails to remedy the deficiencies of Henckel and Hutchinson set forth above in connection with independent claims 1, 9, and 33. Ho is only relied upon to teach invoking a training mode and providing audio indicators to teach the association.

**IV. Rejection Should Be Withdrawn**

At least for the reasons set forth above, the Examiner's rejection is improper under § 103 because (1) it fails to provide a teaching or suggestion in the prior art of each and every claimed feature and (2) the proposed combination of Henckel and Hutchinson would be improper. Further, as discussed above, agreement was reached during the March 21, 2008 interview that the above claim amendments are sufficient to overcome the § 103 rejections. Accordingly, claims 1, 9, and 33 are in condition for allowance, and claims 4, 12, 22, 27, 29-32, 34-40, 42-45, and 47-49 are allowable at least by virtue of their dependency on allowable independent claims. Therefore, the Examiner is respectfully requested to reconsider and withdraw the § 103 rejections.

*Conclusion*

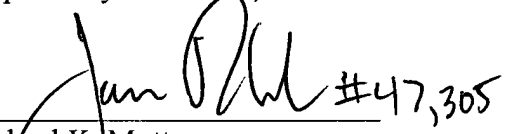
In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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